

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YONGMEI CANG AND SHU LIN

Appeal 2007-1537
Application 09/916,903
Technology Center 2600

Decided: September 17, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
ANITA PELLMAN GROSS, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and system for creating a subset of programming channels in a digital video system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of creating a subset of channels with programming from a plurality of channels, comprising the steps of:

receiving a plurality of channels, wherein the plurality of channels comprises at least one channel with programming;

encoding at least a portion of a predetermined number of channels from the plurality of channels to provide corresponding encoded intra and/or non-intra pictures for each of the predetermined number of channels;

processing at least one of the corresponding intra and/or non-intra pictures for each of the predetermined number of channels to determine which of the predetermined number of channels contain programming to provide the subset of channels with programming; and

storing the subset of channels into memory.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

ELENBAAS	US 2005/0028194 A1	Feb. 3, 2005 (Eff. Filing date Dec. 23, 1998)
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BARTON	US 6,233,389 B1	May 15, 2001
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REJECTIONS

Claims 1-17¹ are rejected under 35 U.S.C. 103(a) as being unpatentable over Elenbaas in view of Barton.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 29, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Oct. 30, 2006) and Reply Brief (filed Jan. 19, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art

¹ We note that dependent claim 17 indicated "the subset of channels," but independent claim 10, from which 17 depends, recites "a subset of channel indicators." We leave it to the Examiner to determine if there is a problem with antecedent basis or claim dependency where dependent claim 17 should depend from independent claim 16 which recites a subset of channels.

references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) objective indicia of non-obviousness.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966)).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

Discussing the question of obviousness of a claimed combination of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it,

either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [v. *AG Pro, Inc.*, 425 U.S. 273, 189 USPQ 449 (1976)] and *Anderson's-Black Rock* [Inc. v. *Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Where, on the other hand, the claimed subject matter involves more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness must be based on “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, it is not necessary to look only to the problem the patentee was trying to solve; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added).

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands

known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. *See also Leapfrog*, 485 F.3d at 1162, 82 USPQ2d at 1691 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336). Further, as pointed out by our reviewing court,

we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited and disputed in independent claim 1.

At the outset, we note that Appellants’ main contention is that the combination of Elenbaas and Barton does not teach or fairly suggest the recited steps of encoding and processing to produce a subset of channels or channel indicators, and we further clarify in a digital video system. From our review of Appellants’ Specification, we note that Appellants admit that providing a subset of channels in an analog television system was well known, and that it was fairly easy to determine due to snow/noise on the channel. (Spec. 1). Therefore, we note that a corresponding method was known in an analog system, but for whatever encoding and determining was done in the digital system. Arguably there is some encoding and determining done in the analog systems, yet that issue is not before us, and we turn to the combination of Elenbaas and Barton.

Appellants’ main contention is that Elenbaas and Barton do not teach the “processing at least one of the corresponding intra and/or non-intra pictures [as encoded] for each of the predetermined number of channels to determine which of the predetermined number of channels contain programming to provide the subset of channels with programming” (Br. 19-26). The Examiner maintains the Elenbaas teaches the processing to determine the subset of channels “of interest to the user” (Answer 3). While we agree with the Examiner that Elenbaas does determine channels of

interest to a user, it is the presence or absence of “programming” that is required.

The determination in Elenbaas begins with all channels that contain programming and then matches those programs to user preferences. From those portions of Elenbaas referenced by the Examiner and our review of the teachings of Elenbaas, we find no clear teaching or suggestion of the determination of the presence or absence of programming to determine a subset of channels. Nor do we find that Barton remedies this deficiency in Elenbaas. Therefore, we conclude that the Examiner has not established a prima facie case of obviousness by showing all the limitations are taught or fairly suggested in the prior art applied. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-7. Similarly, we cannot sustain the rejection of independent claims 8, 10, and 16 and their dependent claims 9, 11-15, and 17 for the same reason.

CONCLUSION

To summarize, we have not sustained the rejection of claims 1-17 under 35 U.S.C. § 103(a).

REVERSED

KIS

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